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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,998	03/02/2004	Joseph S. Ng	04-0143	4304
74576	7590	03/24/2009	EXAMINER	
HUGH P. GORTLER			PLUCINSKI, JAMISUE A	
23 Arrivo Drive			ART UNIT	PAPER NUMBER
Mission Viejo, CA 92692			3629	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/791,998	<b>Applicant(s)</b> NG ET AL.
	<b>Examiner</b> JAMISUE A. PLUCINSKI	<b>Art Unit</b> 3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 22 December 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 27-31 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 27-31 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/0256/06)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 27 is rejected under 35 U.S.C. 102(e) as being anticipated by Webb, Sr. (US 2004/0257225).
3. With respect to Claim 27: Webb discloses the use of a system for maintaining security of a cargo container during shipment from an origination point to a destination (See abstract) comprising:

- a. Means for determining geographic location of the cargo container during shipment from the origination point to the destination (Reference numerals 142, 241 with corresponding detailed descriptions and Paragraphs 0056 and 0057); and
- b. A battery-powered (paragraph 0069) container security unit (200) for the container, the CSU reporting on status of the cargo container during the shipment (Reference numerals 270, 237 and Paragraph 0068). Webb discloses reporting and transmitting the data periodically and transmits only within range of the satellite, (Paragraphs 0073, 0078, 0084 and 0098), however the reporting being done on a frequency that is a function of the geographic location of the container, in considered to be intended use system. It has been held that a recitation with respect to the manner in

which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPW2d 1647 (1987), *In re Paulsen*, 30 F. 3d 1475, 31 USPQ 2d 1671 (Fed. Cir. 1994). The claim is directed to a system, which is in essence an apparatus claim, which is held to the structural limitations. Webb discloses all the structural limitations of the claim, therefore anticipates Claim 27.

4. Claims 27-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Peel et al. (US 2008/0117040).

5. With respect to Claim 27: Peel discloses the use of a system for maintaining security of a cargo container during shipment from an origination point to a destination (see abstract), the system comprising:

- c. Means for determining geographic location of the cargo container during shipment from the origination point to the destination (See Reference numeral 100 with corresponding detailed description); and
- d. A battery powered (paragraph 0120) container security unit for the container, the CSU reporting on status of the cargo container during the shipment (See Reference numerals 190 and Paragraphs 0046 and 0076). The reporting being done on a frequency that is a function of the geographic location of the container, in considered to be intended use system. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*,

2 USPW2d 1647 (1987), *In re Paulsen*, 30 F. 3d 1475, 31 USPQ 2d 1671 (Fed. Cir. 1994). The claim is directed to a system, which is in essence an apparatus claim, which is held to the structural limitations. Peel discloses all the structural limitations of the claim, therefore anticipates Claim 27.

6. With respect to Claim 28: Peel discloses the use of a CSU bridge Reference numeral 180 with corresponding detailed description). With respect to the term “for allowing the CSU to communicate via a low power wireless network connection”, the term allowing is given the definition of “not preventing” so as long as the bridge can only function in a high powered environment, then the bridge would be allowing the CSU to communicate via a low-power environment. Peel discloses the CSU to be battery powered or solar powered, therefore due to the fact that the present invention considers battery powered to be a lower power environment, then the examiner considers the battery power CSU of Peel to be a low powered environment.

7. With respect to Claims 29 and 30: Peel discloses the Bridge being located on the ship which moves the cargo and communicates via satellite on the water, therefore attached to the moving cargo means and in a location where direct communication links are not available (See Figures 1 and 2 with corresponding detailed description).

8. With respect to Claim 31: Peel discloses, in paragraph 0053, there is two way communication between the CSU bridge and the CSU, therefore fully capable of providing information to the CSU, what that information is regarding, whether it be positional information or not, is considered to be intended use of the system. Systems are held to the structural limitations and the capabilities thereof and it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the

claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USP2d 1647 (1987), *In re Paulsen*, 30 F. 3d 1475, 31 USPQ 2d 1671 (Fed. Cir. 1994).

***Response to Arguments***

9. Applicant's arguments with respect to claim 28 have been considered but are moot in view of the new ground(s) of rejection.
10. With respect to Applicant's argument in terms of Claim 27: The applicant is arguing the claims, that the frequency of the reporting is a function of the geographic location. As stated above, the claims are directed to a system, which are held to the structural limitations as well as the functionalities/capabilities thereof. Webb discloses the use of a reporting feature, therefore how often the reporting is being done, or the frequency of the reporting is considered to be intended use of the system, and does not structurally effect the system, as claimed.

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/  
Examiner, Art Unit 3629